

REMARKS

1. Summary of Case Status

All of claims 1 – 20 pending in the case currently stand rejected.

Claims 1 – 12, 13 and 15 – 20 were rejected under 35 USC 103(a) as being obvious given US Patent 6,234,677 of Mogil in view of US Patent 5,501,338 of Preston;

Claims 1 – 11, 16, 17, 19 and 20 were rejected under 35 USC 103(a) as being obvious given Mogil in view of US Patent 5,403,095 of Melk;

Claim 14 was rejected under 35 USC 103(a) as being obvious given Mogil and Melk and further in view of US Patent 5,020,921 of Beales;

Claims 3 and 4 were rejected under 35 USC 103(a) as being obvious given Mogil and Preston, (or alternatively Mogil and Melk); and further in view of the identified references of Arreazola, Sloan, Rucker and Ellison;

2. General Traverse of Rejections

As a preliminary matter, the Applicant again makes a general traverse of any and all rejections of each claim pending in the case and requests reconsideration and withdrawal of those rejections. As a further preliminary matter, the Applicant incorporates by reference the arguments made in previous responses in this matter, and, in particular those arguments presented in respect of the issue of teaching away, including the case law citations therein.

3. Art Based Rejections – Mogil Teaches Collapsible Coolers

As previously, all of the rejections rely on the inventor's own US Patent 6,234,677 as the principal reference.

The Applicant respectfully points out that the apparatus shown and described in the Mogil reference upon which the rejection relies is a double cooler in which both sides of the cooler are collapsible, as shown in Figures **20**, **21**, and **27 – 32** thereof. The Mogil reference explicitly teaches, and claims, that both sides are collapsible. See col. 3, lines 56 – 67; col. 13, lines 20 – 24 and col. 13, line 30 to col. 14 line 3; and independent claims 1, 2, 8, 10, 28 and 29.

Indeed, every claim of the Mogil reference is either directly or indirectly for “A soft-sided, *collapsible*, insulated container comprising: ...”

It is therefore plain on the face of the document that Mogil teaches away from the Applicant's claimed invention, which, in each and every claim requires a rigid reinforcement “... such that said first portion has a non-collapsible rigid form.”, in the words of claim 1, and “said first portion being non-collapsible” in the words of claim 16.

4. Office Action Response Commentary

The Office Action suggests at page 7 that the teaching away of the primary reference is “unpersuasive”.

(a) Teaching Away – Not an Issue of Persuasiveness

The Applicant respectfully points out that issue is “teaching away”. A *prima facie*

case of obviousness can always be rebutted by showing that the art teaches away from the claimed invention in any material respect. (*In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ 2d 1362, 1366 (Fed. Cir 1997). “Teaching away” is not subject to analysis on the basis of whether it is found to be “persuasive” or “unpersuasive”. The only relevant issue is whether the reference does, or does not, teach away. It is a question of fact, not a discretionary question of persuasiveness.

To the extent that the Office Action of October 7, 2009 purports to apply a different standard, the Applicant respectfully submits that the commentary in the Office Action in paragraph 10 at page 9, under the heading “Response to Arguments”, does not conform to the law, and is not responsive to the Applicant’s previously submitted argument.

In that light, the Applicant again requests that the rejections of all of claims 1 – 20 be reconsidered and withdrawn, and that the case be allowed.

(b) Teaching Away – Reference Inconsistent With Invention

It is said in the Office Action that “Applicant’s sole argument against the prior art is that “Mogil clearly teaches away from a rigid container” is not convincing because applicant fails to submit evidence that the applied Mogil reference expressly discloses that a rigid container is undesirable. Furthermore Mogil discloses the desire for the container to be rigid in order to protect softer contents from harder contents. See col. 13, lines 1 – 7.”

The Applicant respectfully disagrees, and continues to traverse the rejections.

The Applicant points out that the Office Action makes an incorrect application of the law. “Teaching away” does not require that the reference explicitly note the other teaching

and explicitly discourage that teaching, as implied in the Office Action.

The test for “teaching away” is met when a person of ordinary skill in the art would understand that the teaching in the first reference is inconsistent with the teaching of the second reference with which it is to be combined to establish *prima facie* grounds of rejection. That is, the reference leads a person skilled in the art “away” from the combination or modification proposed. It is abundantly clear, and plainly undeniable, that the Mogil disclosure leads a person skilled in the art to collapsible structures, not rigid ones. The addition of a rigid bucket to Mogil’s structure is therefore clearly, and undeniably, inconsistent with Mogil’s teaching.

(c) Teaching Away – Destruction of Function

It is long established law that an invention cannot be obvious if the proposed combination or modification would destroy the functionality of the reference. (*In re Gordon*) Here, every claim in Mogil is for a collapsible insulated container. It is beyond rational argument, then, that the incorporation of a rigid tub would destroy the collapsible functionality of Mogil’s claimed invention. *Prima facie* grounds for rejection cannot therefore be established on the basis of a combination of either (a) Mogil and Preston; or (b) Mogil and Melk.

(d) Mogil Unambiguously Teaches and Claims a Collapsible Cooler

Considering the reference, again, in detail, first, the Mogil double cooler application (now US Patent 6,234,677) expressly indicates at col. 13, lines 20 – 23 that:

"Figs. **15 – 31** show an alternative type of soft-sided, insulated wall, collapsible container assembly, indicated generally as **500**.

At col. 13, lines 30 – 33 the application states:

"The basic lid, bottom, and sidewall construction of each of the first and second portions [*i.e.*, portions **502** and **504** identified at col. 13, lines 22 – 24] is the same as described above in the context of containers **22** and **422**."

At col. 6, lines 55 – 56:

"Container **22**, with liner **24** installed, can be folded to a collapsed position as shown in Figs. **1, 7, 8** and **9**. In this collapsed, or storage position ..."

At col. 11, lines 57 – 59:

"Container **422**, with liner **424** installed, can be folded to a collapsed position in a similar manner to that of container **22**, as shown in Figures **7, 8** and **9** and described above."

Thus, the application clearly indicates that both portions **502** and **504** are collapsible in the same manner as containers **22** and **422**. Furthermore the texts tells the reader at col. 5, lines 31 – 35 that Figures **20** and **21** show the double cooler assembly in the collapsed position. Looking at the illustrations the reader can observe that Figures **15 – 19** and **22 – 26** show the assembly in the expanded position; Figures **20 – 21** and **27 – 31** show it in the collapsed position

It is therefore beyond the realm of reasonable dispute that (a) the double cooler identified as item **500** is a collapsible cooler; and (b) the specification provided by Mogil

describes it as such, *and nothing else*.

Further, the Mogil application describes many embodiments of foldable liners for use in those coolers, the whole underlying premise being that the liners fold up with the soft-sided, insulated, collapsible wall structures, as indicated at col. 6 lines 55 – 56 and col. 11, lines 57 – 59, quoted above. This is far more than sufficient to teach a person skilled in the art that the container is to be collapsible, not rigid.

Further still, Mogil explains the purpose and use of straps **534**, **536** and **552**, **554**, and co-operating hook-and-eye fabric strips **538**, **540**, **542**, **544**, **556**, **558**, **560**, **562**. The existence of these parts is inconsistent with any suggestion that the respective containers be anything other than collapsible. That existence is indeed “the kind of teaching that would discourage a person having ordinary skill in the art from providing a non-collapsible member within” Mogil’s insulated portions.

There is no possible room for doubt that Mogil is teaching that both sides of the container are to be collapsible, not rigid. There is, therefore, no room left for a person of ordinary skill in the art to make the interpretation made in the Office Action of June 7, 2010 to the contrary.

(e) The Divider

The Office Action cites the existence of the divider (item **425**) as an indication that Mogil suggests the use of a rigid container. The Applicant respectfully disagrees. The divider partition of Mogil does not prevent the Mogil collapsible cooler portions from being moved to their collapsed position. On the contrary, it is a planar panel that sits against the

rear wall of the container when the container is folded. This simply cannot be done with a rigid liner as shown and described in either Preston or Melk.

5. Concluding Commentary

As discussed above Mogil is directed to and teaches a collapsible container. And thus clearly does not disclose or suggest a substantially rigid noncollapsible reinforcement member as in the Applicant's claimed invention. Furthermore, to modify Mogil to include such a rigid noncollapsible reinforcement member in Mogil would be contrary to the teachings of this reference and could make the reference unfit for its intended purpose which is a collapsible container. Therefore, it is clear that Mogil teaches away from the Applicant's claimed invention and is therefore not a proper reference and can not be combined with other references to teach the Applicant's claimed invention.

Since Mogil teaches away from the Applicant's claimed invention, it is respectfully submitted that it would not be obvious to combine the teachings of Mogil with the teachings of Preston, Melk, Beales, Arreazola, Sloan, Rucker or Ellison taken to render obvious the Applicant's claimed invention as set forth in claims 1 and 16.

Claims 2-15 depend from Claim 1 and Claims 17-20 depend from Claim 16 and thus include the limitations of their respective independent claims. Thus, it is respectfully submitted that the Applicant's claimed invention as set forth in Claims 2-15 and 17-20 are not obvious in view of the cited prior art for at least the reasons discussed above with respect to Claims 1 and 16.

The Applicants respectfully submit that all of the claims presently pending in this case are in a condition for allowance. The Applicants therefore respectfully request early and favourable disposition of this matter.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 01-2300, under Order No. 024643.00015 from which the undersigned is authorized to draw.

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Respectfully submitted,

By



Charles M. Marmelstein
Registration No.: 25,895
Attorneys for Applicant(s)
Customer No. 04372
Arent Fox LLP
1050 Connecticut Avenue, N.W.
Suite 400
Washington, D.C. 20036-5339
Tel 202.857.6000
Fax 202.857.6395
dcipdocket@arentfox.com